JUDGMENT OF THE COURT OF FIRST INSTANCE (Second Chamber)

12 July 2006 *

In Case T-277/04,

Vitakraft-Werke Wührmann & Sohn GmbH & Co. KG, established in Bremen (Germany), represented by U. Sander, lawyer,

applicant,

v

Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM), represented by J. Novais Gonçalves, acting as Agent,

defendant,

the other party to the proceedings before the Board of Appeal of OHIM, intervener before the Court of First Instance, being

* Language of the case: English.

Johnson's Veterinary Products Ltd, established in Sutton Coldfield (United Kingdom), represented by M. Edenborough, Barrister,

ACTION for the annulment of the decision of the First Board of Appeal of OHIM of 27 April 2004 (Case R 560/2003-1) regarding opposition proceedings between Vitakraft-Werke Wührmann & Sohn GmbH & Co. KG and Johnson's Veterinary Products Ltd,

THE COURT OF FIRST INSTANCE
OF THE EUROPEAN COMMUNITIES (Second Chamber),

composed of J. Pirrung, President, A.W.H. Meij and I. Pelikánová, Judges,

Registrar: J. Plingers, Administrator,

having regard to the application lodged at the Court Registry on 9 July 2004,

having regard to the response of OHIM lodged at the Court Registry on 14 January 2005,

having regard to the response of the intervener lodged at the Court Registry on 13 May 2005,

further to the hearing on 11 January 2006,

gives the following

Judgment

Background to the dispute

1 On 21 March 1996, Vitacoat Ltd applied to the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) for registration of the word sign VITACOAT as a Community trade mark pursuant to Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended.

2 The goods in respect of which registration of the trade mark was sought fall within Classes 3, 5 and 21 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, and correspond to the following description:

— Class 3: 'Shampoos, conditioners, preparations for the hair and skin, deodorants; all for animals';

— Class 5: 'Preparations for killing mites, lice, fleas and other parasites; all for animals';

— Class 21: 'Brushes and combs for animals'.

3 The application for registration was published in *Community Trade Marks Bulletin* No 34/1998 of 11 May 1998.

4 On 25 May 1998 the applicant lodged an opposition against registration of the mark applied for based on four marks registered in Germany (hereinafter 'the earlier marks'), consisting of the word sign VITAKRAFT and protecting inter alia the following goods:

— Registration No 834 153: 'Glassware, porcelain and earthenware, namely feeding dishes for birds, dogs and cats';

— Registration No 950 955: 'Non-pharmacy-restricted veterinary preparations for toy fishes and birds, domestic birds';

— Registration No 1 065 186: 'Preparations for body and beauty care of pets as well as shampoos for pets, sanitary preparations for pets';

— Registration No 39 615 031: 'Laundry substances, soaps, preparations for body and beauty care, hair lotions, preparations for destroying vermin, combs, brushes'.

5 The opposition was based in particular on Article 8(1)(b) of Regulation No 40/94 and directed against all the goods covered by the application for registration.

6 On 11 February 2000, the Opposition Division rejected the opposition on the ground, inter alia, of failure to translate completely the registration certificates of the earlier marks. On appeal by the applicant, the Third Board of Appeal of OHIM annulled that decision on 19 June 2001 in so far as it related to the earlier marks.

7 On 4 September 2001, Vitacoat informed OHIM of the transfer of the trade mark application to Johnson's Veterinary Products Ltd and that transfer was registered in the *Register of Community Trade Marks* on 29 October 2001.

8 On 29 July 2003, the Opposition Division again rejected the opposition as unfounded.

9 On 24 September 2003, the applicant lodged an appeal against the Opposition Division's decision.

10 By decision of 27 April 2004 (hereinafter 'the contested decision') the First Board of Appeal of OHIM dismissed the appeal. In essence it held that the goods at issue were in part identical and in part similar but that the signs at issue included only very few elements of similarity at the visual and aural levels. According to the Board of Appeal, the word 'vita' and the 'VITAKRAFT' marks have only a low inherent distinctive character with respect to the goods other than those covered by German registration No 834 153 and the 'combs and brushes' covered by German registration No 39 615 031. Furthermore, it maintained that they were different at a conceptual level, as the word 'Kraft' meant 'strength, power' in German and thus reinforced the idea of 'vitality' ('Vitalität' in German) suggested by the element 'vita', whereas the word 'vitacoat' had no specific meaning regardless of whether German consumers knew the meaning of the English word 'coat'. As regards the documents submitted by the applicant with a view to proving the highly distinctive character of the earlier

marks on account of the fact that they are recognised on the German market, the Board of Appeal found that they did not constitute sufficient evidence of the reputation of the earlier marks (see paragraphs 24 and 25 below). According to the Board of Appeal, as the applicant was not successful in showing that its marks were recognised on the German market, the similarity of the marks at issue is not sufficient to create a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94.

Procedure and forms of order sought by the parties

11 The application was initially lodged in German. English became the language of the case, pursuant to Article 131(2) of the Rules of Procedure of the Court of First Instance, following objections by the intervener which were lodged at the Registry of the Court of First Instance on 11 August 2004.

12 The applicant included in its application numerous annexes drafted in German. On 31 January 2005 it replaced some of them with abridged versions.

13 Pursuant to Article 131(3) of the Rules of Procedure the applicant was permitted to submit its oral pleadings in German.

14 The applicant claims that the Court should:

— annul the contested decision;

— order OHIM to pay the costs.

15 OHIM claims that the Court should:

— dismiss the action;

— order the applicant to pay the costs.

16 The intervener claims that the Court should:

— dismiss the action;

— uphold the contested decision;

— refer the application for a Community trade mark back to OHIM so that it can register the mark;

— order the applicant to pay the costs incurred by the intervener in connection with the proceedings before the Court of First Instance, the Board of Appeal and the Opposition Division.

17 At the hearing the intervener explained, in answer to a question from the Court, that its second head of claim was, in fact, indissociable from the first. As regards the third head of claim, that, according to the intervener, is intended to ensure that OHIM actually proceeds to register the mark applied for in the event that the action is dismissed. In respect of costs, it stated that it had, as a precaution, formulated the fourth head of claim as widely as possible.

Law

The applicant's claim for annulment of the contested decision

18 The applicant is relying on a single plea in law, alleging breach of Article 8(1)(b) of Regulation No 40/94. That plea in law is essentially made up of three parts. In the first, it submits that the VITAKRAFT marks and their element 'vita' have a highly distinctive character because that mark is recognised on the German market. In the second part of the plea in law the applicant complains that the Board of Appeal made an incorrect appraisal of the similarity of the signs, in particular because it did not perceive the word 'vita' to constitute their dominant element. In the third part, the applicant submits that those two errors and the fact that the Board of Appeal failed to have regard to the degree of similarity of the goods at issue led it to disregard the existence, in the present case, of a likelihood of confusion which has, moreover, been duly acknowledged by German courts in circumstances comparable to those of the present case.

General observations

19 Under Article 8(1)(b) of Regulation No 40/94, upon opposition by the proprietor of an earlier trade mark, the trade mark applied for is not to be registered if because of

its identity with or similarity to the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected.

20 According to settled case-law of the Court of Justice and the Court of First Instance, the likelihood of confusion as to the commercial origin of the goods or services must be assessed globally according to the perception that the relevant public has of the signs and of the goods or services in question and taking into account all factors relevant to the circumstances of the case, inter alia of the interdependence between the similarity of the trade marks and the similarity of the goods or services identified (Case T-57/03 *SPAG* v *OHIM — Dann and Backer (HOOLIGAN)* [2005] ECR II-287, paragraph 51).

21 In the present case, the parties agree on the fact that, as the earlier marks are protected in Germany and the goods are intended for all pet-owners, the target public is composed of average German consumers with pets.

22 Furthermore, as is apparent from paragraphs 21 to 23 of the contested decision, the Board of Appeal found that all the goods covered by the trade mark application were identical to one or other of the goods protected by earlier marks No 1 065 186 and No 39 615 031. In addition it stated, in paragraph 24 of the contested decision, that the goods covered by the mark for which registration was sought and by mark No 834 153 were similar. The applicant did not challenge those findings.

23 It is in the light of those considerations that the applicant's single plea in law must be examined.

The first part of the plea in law relating to whether the earlier marks have a highly distinctive character because they are recognised

— Contested decision

24 Before the Board of Appeal, the applicant submitted the following items of evidence in order to substantiate the fact that its marks are recognised:

— a price list of goods carrying the VITAKRAFT marks for 1994;

— a market survey compiled in 1997 relating to the VITAKRAFT marks;

— a market survey compiled in 1992 relating to the mark VITA and the possible link that the public will make between that mark and the sign VITAKRAFT.

25 The Board of Appeal took no account of the price list because it essentially concerned goods other than those covered by the earlier marks at issue (paragraph 29 of the contested decision). As regards the 1997 survey, the Board of Appeal considered that its evidential value was inconclusive, since the interviewees did not spontaneously make a link between the VITAKRAFT marks and the products protected by them as the interviewers showed them the sign and mentioned the goods at issue (paragraph 30 of the contested decision). As regards the 1992 survey, the Board of Appeal took the view that its evidential value was considerably reduced as it did not cover the relevant period. According to the Board of Appeal, it must be assumed that market conditions and consumer perceptions change considerably in four years unless there is evidence to the contrary. It added that the survey did not

concern the VITAKRAFT marks, was directed only at consumers with pets, that those consumers were directed to the mark VITA for the goods at issue and that only 20[%] of the interviewees had identified the VITAKRAFT marks (paragraph 31 of the contested decision).

— Arguments of the parties

26 As regards, first of all, the 1994 price list, the applicant states that it also covers goods designated by the earlier marks.

27 Secondly, as regards the 1997 survey, the applicant essentially criticises the fact that the Board of Appeal did not accept the information given to the interviewees as regards the mark and the goods at issue. According to the applicant, it is impossible not to show the mark concerned by a survey during interviews with consumers. At the hearing it added that, as the word 'vita' is an element frequently used in marks protecting goods for human consumption, it was necessary to mention the goods covered by the earlier marks in order to preclude confusion with marks falling within the sector of foodstuffs for human consumption.

28 Lastly, so far as concerns the 1992 survey, the applicant submits, first of all that, as the 1997 survey also shows, the market at issue does not change in the relatively short period of four years. Secondly, it states that the German market research institute Allenbach which carried out that survey is extremely well known. The survey proves that, for a group which is representative of the market at issue, the word 'vita' is the dominant element of the VITAKRAFT marks and that that section of the public makes a direct link between the presence of the word 'vita' in the sign designating the goods at issue and the applicant's earlier marks.

29 OHIM contends, first of all, that the price list cannot on its own prove that the earlier marks were recognised, irrespective of its content.

30 As regards the 1997 survey, OHIM considers that, as a general rule, consumers are not driven to a particular mark but decide spontaneously which product they wish to buy. Consequently, only a spontaneous answer as to a consumer's awareness of a mark for particular goods could provide sufficient evidence that it is recognised on the market. In the present case, firstly, the consumers were steered directly towards the VITAKRAFT marks and, secondly, the survey remains particularly vague regarding the goods covered. At the hearing, OHIM added that the evidential value of the survey was further weakened by the fact that it covered a period subsequent to the relevant period and therefore could have been influenced by advertising campaigns conducted after the date on which the application for registration was filed.

31 Lastly, as regards the 1992 survey, OHIM observes that, according to that survey, 70% of the interviewees made no link between the word 'vita' and the earlier marks although the questions were asked in such a way as to steer the consumers questioned towards a particular result.

32 The intervener considers that the 1997 survey must be disregarded as it relates to a period subsequent to the relevant date and that the evidential value of the 1992 survey is wanting as it does not relate to the earlier marks but to the sign VITA. At the hearing it stated that the questions put to the interviewees in 1992 could, at the very most, show some association between the signs VITA and VITAKRAFT.

— Findings of the Court

33 As is apparent from the seventh recital in the preamble to Regulation No 40/94, an appreciation of the likelihood of confusion depends on numerous elements and, in particular, on the public's recognition of the trade mark on the market in question. Since the more distinctive the earlier mark, the greater will be the likelihood of confusion, marks with a highly distinctive character, either *per se* or because of the public's recognition of them, enjoy broader protection than marks with a less distinctive character (see, by analogy, Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 24; Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 18; and Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 20).

34 The existence of an unusually high level of distinctiveness as a result of the public's recognition of a mark on the market necessarily presupposes that at least a significant part of the relevant public is familiar with it, without its necessarily having to have a reputation within the meaning of Article 8(5) of Regulation No 40/94. It is not possible to state in general terms, for example by referring to given percentages relating to the degree of recognition attained by the mark within the relevant section of the public, that a mark has a highly distinctive character because of the public's recognition of it (see, to that effect and by analogy, Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 52, and *Lloyd Schuhfabrik Meyer*, paragraph 24). Nevertheless, it must be acknowledged that there is a certain interdependence between the public's recognition of a mark and its distinctive character in that the more the mark is recognised by the target public, the more the distinctive character of that mark is strengthened.

35 In order to assess whether a mark has a highly distinctive character as a result of the public's recognition of it, all the relevant facts of the case must be taken into consideration, in particular the market share held by the mark; how intensive,

geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see, by analogy, *Windsurfing Chiemsee*, paragraph 51, and *Lloyd Schuhfabrik Meyer*, paragraph 23, and, to that effect and by analogy, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraphs 26 and 27).

36 In the present case, the applicant has submitted three items of evidence to substantiate the public's recognition of its earlier marks, namely a price list from 1994, a market survey from 1997 and a market survey from 1992 (see paragraph 24 above).

37 First, as regards the price list, it must be borne in mind that the mere submission of catalogues without any indications or evidence relating to their distribution to the public or the extent of any potential distribution is not sufficient to show use of a mark (see, to that effect, Case T-356/02 *Vitakraft-Werke Wührmann* v *OHIM — Krafft (VITAKRAFT)* [2004] ECR II-3445, paragraph 34). *A fortiori*, it cannot prove how intensive such use has been. That case-law can be applied to a price list the function of which may be approximated to that of a catalogue. Therefore, the applicant's argument that the Board of Appeal erred as regards the content of that price list must be rejected.

38 Secondly, as regards the market surveys compiled in 1992 and 1997, it must be pointed out, first of all, that in order to have an unusually high level of distinctiveness as a result of the public's potential recognition of it, an earlier mark must, in any event, be familiar to the public on the filing date of the trade mark application or, as the case may be, on the priority date relied on in support of that application (see, to that effect, Case T-8/03 *El Corte Inglès* v *OHIM — Pucci (EMILIO PUCCI)* [2004] ECR II-4297, paragraphs 71 to 73, not appealed on those

points). None the less, it is not in principle inconceivable that a survey compiled some time before or after that date could contain useful indications, although it is clear that its evidential value is likely to vary depending on whether the period covered is close to or distant from the filing date or priority date of the trade mark application at issue. Furthermore, its evidential value depends on the survey method used.

39 In the present case the evidential value of the 1997 survey is weakened, as the Board of Appeal rightly observes, by the fact that the interviewees did not answer spontaneously, since the questionnaires used showed them the sign at issue and mentioned the goods. That finding is not called into question by the applicant's argument, first that it was necessary to specify the goods concerned to prevent the interviewees' indicating trade marks for food intended for human consumption and, second, that a survey without any reference to the mark concerned leads to useful results only in cases where the marks enjoy a high degree of recognition ('berühmte Marken') (see paragraph 27 above). It would have been possible to mention to the interviewees the goods concerned without referring to the VITAKRAFT marks or to show them a list of different marks one of which was the earlier sign at issue.

40 Accordingly, the Board of Appeal did not err in law in finding that the 1997 survey was not enough on its own to establish the public's recognition of the VITAKRAFT marks. There is thus no need for the Court of First Instance to rule on the additional argument put forward by OHIM and the intervener that the evidential value of the survey is also weakened by the fact that it covers a period subsequent to the relevant date.

41 The 1992 survey, for its part, cannot automatically be disregarded on the sole ground that it relates primarily to the mark VITA and not to the VITAKRAFT

marks, since, first, the applicant seeks to establish that the word 'vita' is the dominant element of the earlier marks, in that the target public makes an immediate link between the term 'vita' and the VITAKRAFT marks as a result of its recognition of both signs, and, second, a question in the survey specifically concerns that possible link.

42 However, as the Board of Appeal rightly found, the evidential value of the 1992 survey is weakened by the fact that it was carried out nearly four years before the filing date of the trade mark application at issue. Furthermore, as the Board of Appeal observed, the percentage of people making a direct link between the word 'vita' and the earlier marks is not sufficiently high to establish that those marks or their 'vita' element have a highly distinctive character as a result of the public's recognition of them. The question which the interviewers put to consumers led them to make an economic link between the VITAKRAFT marks and any sign including the word 'vita' and the possibility of any other elements alongside the term 'vita' was unlikely to enter the mind of the consumer being questioned. Even in those circumstances, only 33% of interviewees with pets thought that all the signs which included the element 'vita' belonged to the same undertaking. Only 25% of interviewees with pets made the link between the term 'vita' and a VITAKRAFT mark or undertaking.

43 Furthermore, the Board of Appeal correctly pointed out that the consumers had been informed of the goods concerned (pet care products) and the marks in question (VITA and VITAKRAFT). In view of the fact that the questions put to the consumers were likely to prompt them to give an answer that tended to be favourable to the applicant, the Board of Appeal rightly found that the 1992 survey was not sufficient to establish that those earlier marks were recognised and consequently to prove their highly distinctive character or the highly distinctive character of their element 'vita'.

44 On those grounds, since the applicant has not shown to the requisite legal standard that the earlier marks had a highly distinctive character as a result of the public's recognition of them, the first part of the plea must be rejected as unfounded.

The second part of the plea relating to incorrect appraisal of the similarity of the marks at issue

— Arguments of the parties

45 As regards the comparison of the signs at issue, the applicant denies, first of all, that the element 'vita' has low inherent distinctive character even if the Board of Appeal were justified in finding that the target public associates that word with the German words 'vital' and 'Vitalität'. Firstly, even if that Latin word, meaning 'life', is sometimes used by a minority of people in educated German circles to refer to 'the course of a person's life' ('Lebenslauf' in German), that meaning is not familiar to the majority of German consumers. Secondly, the applicant submits that, contrary to the findings of the Board of Appeal, the German words 'vital' and 'Vitalität' are not descriptive of the goods covered by the earlier marks. Furthermore, the applicant observes that OHIM has already acknowledged the distinctive character of the word 'vita' by publishing, on 15 July 2002, an application for the Community word mark VITA covering goods similar to those designated by the earlier marks.

46 As a result of the public's recognition of the earlier marks, the word 'vita' is, according to the applicant, the dominant element thereof.

47 Irrespective of the foregoing, the applicant objects to the assessment of the similarity of the signs made by the Board of Appeal at the visual, conceptual and phonetic levels.

48 As regards, first, visual similarity, the applicant states that consumers do not carry out a linguistic analysis of a mark. On the contrary, as their level of attention is relatively low at the time of choosing the goods in question, the fact that the first part of the signs VITAKRAFT and VITACOAT and the letters 'a' and 't' in the second part thereof are identical could lead them to confuse the signs at issue. At the hearing, the applicant highlighted the fact that consumers pay more attention to the beginning of a word mark than to its ending.

49 As regards, secondly, conceptual similarity, according to the applicant, the Board of Appeal erred in considering that, irrespective of whether they know the meaning of the English word 'coat', consumers will not associate that word with the reference to the German words 'vital' and 'Vitalität'. The applicant submits that many German consumers know that the word 'coat' can mean 'Fell' in German so that they grasp the descriptive nature of the sign for which registration is sought. Furthermore, the target public's understanding of the word 'coat' does not mean that the conflicting marks are conceptually different but, on the contrary, highlights their conceptual similarity.

50 At the hearing, the applicant added that, in accordance with the case-law of the Court of First Instance (Case T-292/01 *Phillips-Van Heusen* v *OHIM — Pash Textilvertrieb und Einzelhandel (BASS)* [2003] ECR II-4335, paragraph 54; Case T-185/02 *Ruiz-Picasso and Others* v *OHIM — DaimlerChrysler (PICARO)* [2004] ECR II-1739, paragraph 56; and Case T-336/03 *Éditions Albert René* v *OHIM — Orange (MOBILIX)* [2005] ECR II-4667, paragraph 80, under appeal), a conceptual

difference capable of counteracting to a large extent the visual and phonetic similarities of the signs in question would exist only if the sign in its entirety had a clear and specific meaning. In its opinion, that is not the case here since the words 'vitakraft' and 'vitacoat' have no specific meaning either in German or English.

51 As regards, thirdly, phonetic similarity, on the one hand, the applicant submits that this cannot be counteracted by the supposed conceptual difference between the signs which it denies exists in the present case. On the other hand, the Board of Appeal's finding that the presence of the letters 'r' and 'f' in the earlier marks precludes phonetic similarity runs counter to the principle that the existence of a likelihood of confusion must be assessed on the basis of the elements of similarity between the signs and not their differences.

52 OHIM and the intervener do not accept the applicant's arguments.

— Findings of the Court

53 As is clear from settled case-law, the global assessment of the likelihood of confusion must, as regards the visual, phonetic or conceptual similarity of the disputed signs, be based on the overall impression created by them, bearing in mind, inter alia, their distinctive and dominant components (see *BASS*, paragraph 47, and the case-law cited).

54 First of all, concerning the degree of distinctive character of the word 'vita', the relevant public, made up of average German consumers who have a pet, will

understand the word 'vita', which does not exist as such in German, as referring to words like 'vital' and 'Vitalität'. Even if a word of Latin origin is less familiar to a German-speaking consumer than to a Spanish consumer, the word 'vita' evokes generally a positive quality attributable to a large range of different goods or services. The word 'vita' constitutes a prefix which gives the word following it, namely the German word 'Kraft' (strength, power), a connotation of 'vitality'. Accordingly, in the present case, the public will not perceive it as the distinctive and dominant component of the earlier sign. Therefore, the applicant's argument that the word 'vita' has an inherent highly distinctive character must be rejected. Furthermore, as is apparent from paragraphs 33 to 44 above, the word 'vita' is not particularly distinctive as a result of the public's recognition of the earlier marks either, nor is it distinctive as a result of an economic link that the target public might make between the proprietor of the earlier marks and the VITA marks.

55 The fact that the application for a Community word mark VITA for goods similar to those covered by the earlier marks was published by OHIM does not invalidate that assessment. Consideration does not have to be given to whether the sign is 'devoid of any distinctive character' or 'purely descriptive' so that it would meet with a refusal of registration under Article 7(1)(b) or (c) of Regulation No 40/94. It need merely be ascertained whether the word 'vita' is the dominant component of the earlier marks.

56 Secondly, as regards visual similarity, the signs at issue are composed of the element 'vita' and the element 'kraft' or 'coat'. They therefore have their first part ('vita'), the last letter ('t') and a letter in the middle of their second part ('a') in common. Furthermore, their length is nearly identical. In spite of those elements of similarity, the difference between the second part of the words, namely the components 'kraft' and 'coat', produces a different overall impression. Consequently, the Board of Appeal was right in finding that, as regards the overall visual impression, the differences outweighed the elements of similarity.

57 At a phonetic level, it must be observed that the word 'vitakraft' can be broken down into three syllables ('vi', 'ta' and 'kraft') with a sequence of vowels (i — a — a) and a certain striking phonetic quality to the consonants 'r' and 'f', the consonants 'k' and 't' being voiceless and short. The main stress falls on the first syllable with lighter stress on the last syllable. By contrast, as regards the sign for which registration is sought, it must be observed that English words are fairly common in advertising in Germany with the result that many consumers are likely to know at least the rules of pronunciation of English. Thus, they will pronounce the word 'coat' as one sound, very close to 'co:t'. On the other hand, since the word 'vita' resembles the German words 'vital' and 'Vitalität' consumers will not replace the German pronunciation of that word ('vi :ta') with the English pronunciation ('vaita'). The mark for which registration is sought is thus made up of three syllables with a sequence of vowels 'i — a — o' and 'c' and 't' as the only consonants in the second part, with stress falling on the first syllable. On account of the difference in pronunciation between the third syllable of the words 'vitakraft' and 'vitacoat', it must be concluded, as did the Board of Appeal, that the phonetic differences are significant.

58 Lastly, at the conceptual level, the Board of Appeal rightly found that the association in the earlier marks of the words 'vita', linked to the notion of vitality, with 'kraft', meaning 'strength, power' in German, would lead consumers to associate the word 'vitakraft' with the quality of strengthening or regaining health and vitality, although the word does not exist as such in German. As regards the mark for which registration is sought, the word 'coat' has no meaning in German and it is unlikely that consumers will understand the English word 'coat'. At the very most, they know that that word can be understood in the sense of an outer garment in English. In any event, even if they know all its meanings, the fact remains that those meanings are clearly different from that of the word 'Kraft'. Furthermore, the possible understanding on the part of consumers of the meaning of 'coat' will not lead them to perceive the word 'vita' as being the dominant element of the mark for which registration is sought any more than as being the dominant component of the earlier marks. The overall conceptual impression will be that of a whole in which the prefix 'vita' gives to the word 'coat' which follows it a certain connotation linked to the idea of 'vitality', those two words thus forming a unit in which neither can be considered dominant in relation to the other.

59 Consequently, it must be held that there is a slight visual similarity constituted, essentially, by the first four letters of both signs being identical, but considerably diminished on account of the difference between the second part of the signs at issue, namely the words 'kraft' and 'coat'.

60 Likewise, there is a slight phonetic similarity constituted by the identical nature of the first two syllables ('vi — ta'), but considerably diminished by the phonetic difference between the word 'kraft' (marked by the presence of the vowel 'a' and the consonants 'r' and 'f') and 'coat' (marked by the presence of the vowel 'o').

61 Lastly, given that the word 'Kraft' has a specific meaning which is immediately obvious to German consumers, whereas the word 'coat' will have no meaning for them or will be recognised, at the very most, as being an English word which has a different meaning, it must be held that there is a marked conceptual difference between the signs. Such a conceptual difference is capable of counteracting to a large extent the slight visual and phonetic similarities of the signs at issue (see, to that effect, *BASS*, paragraph 54). The presence of the prefix 'vita' in the conflicting signs does not alter that assessment; it will be perceived as a prefix so that the overall impression made by the signs is to a large extent determined, at the conceptual level, by the second part of the signs.

62 In view of the conceptual difference between the signs at issue and their different visual and phonetic features, the Board of Appeal's finding that the signs are similar only to a very slight extent, as the conceptual difference is likely to counteract to a large extent the elements of visual and phonetic similarity, must be upheld.

The third part of the plea relating to the existence of a likelihood of confusion

— Arguments of the parties

63 The Board of Appeal's overall assessment of the likelihood of confusion is, according to the applicant, marred by the following errors.

64 First, it did not take into account the highly distinctive character of the earlier marks resulting from the fact that they are recognised on the market. Secondly, it underestimated the degree of similarity of the conflicting signs. Thirdly, the Board of Appeal did not attach enough importance to the identity of the goods covered by the marks at issue.

65 Lastly, the applicant pleads that German courts have, in comparable cases, regularly acknowledged the existence of a likelihood of confusion, as is apparent from the judgments of those courts annexed to the application.

66 OHIM and the intervener do not accept those arguments. Furthermore, OHIM maintains that, since the judgments of the German courts were not submitted during the proceedings before it, those documents must be declared inadmissible.

— Findings of the Court

67 As a preliminary point, it is appropriate to state that, as is apparent from paragraphs 44 and 62 above, the Board of Appeal did not err in holding, first, that the earlier marks did not have a highly distinctive character resulting from the public's recognition of them and, second, that the signs at issue were only very slightly similar.

68 Secondly, it must be observed that the Board of Appeal took into account the identity of the majority of the goods designated by the marks in question. However, it considered that there were enough differences between the signs, particularly at the conceptual level, to preclude the existence of a likelihood of confusion even in relation to identical goods. The Court of First Instance upholds that finding, even taking into account the low degree of attention given to the choice of the goods in question.

69 Lastly, as regards the German case-law cited by the applicant, it must be noted, first of all, that the German judgments were put forward for the first time before the Court of First Instance.

70 According to settled case-law, the purpose of actions brought before the Court of First Instance is to review the legality of decisions of the Boards of Appeal within the meaning of Article 63 of Regulation No 40/94. Facts which are pleaded before the Court of First Instance without having previously been brought before the departments of OHIM can affect the legality of such a decision only if OHIM should have taken them into account of its own motion. It follows from the concluding words of Article 74(1) of Regulation No 40/94, according to which, in proceedings relating to relative grounds for refusal of registration, OHIM is to be restricted in its examination to the facts, evidence and arguments provided by the parties and the relief sought, that OHIM is not required to take into account of its

own motion facts which have not been put forward by the parties. Therefore, such facts cannot affect the legality of a decision of the Board of Appeal (Case T-115/03 *Samar* v *OHIM — Grotto (GAS STATION)* [2004] ECR II-2939, paragraph 13).

71 Nevertheless, it must, however, be pointed out that neither the parties nor the Court of First Instance itself can be precluded from drawing on national or international case-law for the purposes of interpreting Community law. That possibility of referring to national judgments is not covered by the case-law referred to in paragraph 70 above since it is not alleged that the Board of Appeal failed to take the factual aspects of a specific national judgment into account but that it infringed a provision of Regulation No 40/94 and the case-law is cited in support of that plea.

72 In the present case it must, however, be stated that the decisions of the German court cited by the applicant do not undermine the contested decision. Firstly, for the reasons set out in paragraph 70 above, they cannot cast doubt on the Board of Appeal's findings of fact, or prove that the earlier marks are recognised on the market by the public or that a German consumer associates the word 'vita' with the applicant's marks. Secondly, the applicant has not put forward any particular legal argument from those judgments which may be drawn on under the conditions set out in paragraph 71 above.

73 It is apparent from the foregoing that the Board of Appeal did not err in its overall assessment of the likelihood of confusion. Therefore, the third part of the plea is unfounded. Accordingly, the applicant's single plea in law must be rejected and the action must therefore be dismissed.

The intervener's application seeking registration of the mark

74 As regards the intervener's third head of claim, it must be borne in mind that Article 63(6) of Regulation No 40/94 requires OHIM to take the measures necessary to comply with a judgment. Accordingly, the Court of First Instance cannot issue directions to OHIM. It is for OHIM to draw the appropriate inferences from the operative part of this judgment and the grounds on which it is based (Case T-163/98 *Procter & Gamble* v *OHIM (BABY-DRY)* [1999] ECR II-2383, paragraph 53; Case T-331/99 *Mitsubishi HiTec Paper Bielefeld* v *OHIM (Giroform)* [2001] ECR II-433, paragraph 33; Case T-34/00 *Eurocool Logistik* v *OHIM (EUROCOOL)* [2002] ECR II-683, paragraph 12; and Case T-388/00 *Institut für Lernsysteme* v *OHIM — Educational Services (ELS)* [2002] ECR II-4301, paragraph 19).

75 Inasmuch as the intervener asks that OHIM proceed with registration, this constitutes ultimately a measure necessary to comply with the judgment and is, in fact, indissociable from the first head of claim seeking to have the action dismissed. If the intervener also thereby intended to ask the Court of First Instance to direct OHIM to register the mark, that claim would be inadmissible in accordance with the settled case-law cited in the preceding paragraph.

Costs

76 Under Article 87(2) of the Rules of Procedure, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. Under Article 136(2) of the Rules of Procedure, costs necessarily incurred

by the parties for the purposes of the proceedings before the Board of Appeal are to be regarded as recoverable costs. The latter provision applies, however, to a situation where the Board of Appeal's decision is annulled, including the operative part concerning the costs. By contrast, where the contested decision is not annulled, even partially, the decision as to costs before OHIM remains valid, subject to a possible appeal.

77 It follows that the intervener's request that the applicant be ordered to pay the costs of the proceedings before the Opposition Division and the Board of Appeal must be dismissed. As regards the costs of the proceedings before the Court of First Instance, since the applicant has been unsuccessful, and the defendant and intervener have applied for costs, the applicant must be ordered to pay the costs.

On those grounds,

THE COURT OF FIRST INSTANCE (Second Chamber)

hereby

1. Dismisses the action;

2. Orders the applicant to bear its own costs, and pay the costs incurred by the Office for Harmonization in the Internal Market (Trade Marks and Designs) and the intervener before the Court of First Instance.

Pirrung Meij Pelikánová

Delivered in open court in Luxembourg on 12 July 2006.

E. Coulon J. Pirrung

Registrar President